

# **EXHIBIT A**



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90008608	9/25/07	4963736	102993-100

KENYON & KENYON LLP  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

Albert J. Gagliardi

ART UNIT	PAPER
3992	20071130

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Albert J Gagliardi  
Primary Examiner  
Art Unit: 3992



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/008,608

PATENT NO. 4963736

ART UNIT 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b> 90/008,608	<b>Patent Under Reexamination</b> 4963736	
	<b>Examiner</b> Albert J. Gagliardi	<b>Art Unit</b> 3992	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The request for *ex parte* reexamination filed 25 September 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☒ PTO-892,      b) ☒ PTO/SB/08,      c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the date of service of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Albert J Gagliardi  
Primary Examiner  
Art Unit: 3992

cc:Requester ( if third party requester )

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## DECISION GRANTING EX PARTE REEXAMINATION

### *Decision on Request*

This is a decision on the Third Party Request for *Ex Parte* Reexamination of claims 1-30 (all the current claims) of US Patent Number 4,963,736 to Douglas *et al.* (*Douglas*). It is considered that a substantial new question of patentability affecting claims 1-30 of the *Douglas* patent of is raised by the request for *ex parte* reexamination.

### *Summary*

The examiner considers a substantial new question of patentability has been raised by at least the following prior art references:

Hanley *et al.*, "Chemistry and Cooling of Transition Metal Cluster Ions" (*Hanley*, also Anderson I)

Anderson *et al.*, "Metal Cluster Ion Chemistry" (*Anderson*, also Anderson II)

Boitnott *et al.*, "Optimization of Instrument Parameters . . ." (*Boitnott*, also Finnigan Paper)\*

Finnigan MAT, "Triple Stage Quadrupole GC/MS/MS/DS System" (Finnigan Data Sheet) \*\*

Johnston, "Energy Filtering in Triple Quadrupole MS/MS (*Johnston*, also Finnigan Application Report) \*\*

Engineering Drawings (Finnigan Schematics) \*\*

\*Old prior art

\*\*Raises SNQ as additional reference only (no separate issue)

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*Issue(s) Raised by Request*

Issue 1

The requester alleges (p. 11) that *Anderson I* raises a substantial new question of patentability regarding at least claims 1-5, 9-18 and 22-30.

Issue 2

The requester alleges (p. 11) that *Anderson II* raises a substantial new question of patentability regarding at least claims 1-5, 9-18 and 22-30.

Issue 3

The requester alleges (p. 11) that *Finnigan* raises a substantial new question of patentability regarding at least claims 1-2, 4-15 and 17-30.

**Note:** The substantial new question of patentability regarding Issue 3 is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. In the present instance, there exists a SNQ based solely on the *Boitnott* patent, the specifics of which will be discussed below.

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#### Additional References

In the Request, several additional references were listed and asserted to raise a substantial new question of patentability only as additional or supporting references. Although the additional references are not considered, in and of themselves, as raising any separate issues of patentability, they will be considered during subsequent reexamination in the same manner as other documents in the Office search files, as well as to any additional degree in which the content and relevance of the information has been discussed or explained.

#### ***Background***

Claims 1-30 are the current claims in the *Douglas* patent which issued 16 October 1990 from application 07/437,047 filed 15 November 1989 and claiming foreign priority to Canadian Application 585,694 filed 12 December 1988. The *Douglas* patent was the also the subject of a previously concluded reexamination proceeding (90/004,771) requested by the patent owner. An *Ex Parte* Reexamination Certificate issued 25 May 1999 confirming the patentability of originally granted claims 1-24 and adding new claims 25-30.

Of the claims for which reexamination is requested, claims 1 (apparatus) and 14 (method) are independent.

Claim 1 is generally directed to a mass spectrometer system including first and second vacuum chambers separated by an inter-chamber orifice, wherein the first chamber includes an AC-only rod set for guiding ions through the first chamber and the second chamber includes an AC and DC rod set for mass filtering the ions. Method claim 14 is generally directed to a method of mass analyzing using such a mass analyzer.

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In a Non-Final Rejection (2/3/1998) of the reexamination proceeding, the reexaminer rejected the all the claims (claims 1-24) as obvious over European Patent Application 0 023 826 to French, J. B. (*French*) in view of *Boitnott* (aka The Finnigan Paper) on the basis that *French* suggested a product of pressure ( $10^{-2}$  to  $10^{-4}$  Torr) and rod length (4 inches (10.16 cm)) in the range of  $0.1016 \times 10^{-2}$  to  $10.16 \times 10^{-2}$  Torr-cm.

Following an Examiner Interview (3/11/1998) and Applicant Arguments (4/6/1998) which included an declaration by inventor French, a Final Rejection (6/2/1998) was issued indicating that the declaration by inventor French was sufficient to establish that the *French* application does not suggest operation wherein the product of pressure and rod length was greater than or equal to  $2.25 \times 10^{-2}$  Torr-cm in a chamber containing a rod set operated with only AC voltages applied.

In a Notice of Intent to Issue a Reexam Certificate (1/12/1999), the reexaminer reiterated the basis for confirmation of claims 1-24 and further indicated the patentability of claims 25-30 (previously rejected as indefinite under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph).

### *Analysis*

#### Issue 1

The *Hanley* reference is new prior art. *Hanley* teaches, among other things, a mass spectrometer system with a first chamber operated at a pressure of  $\approx 10^{-2}$  torr with clusters passing through the cell undergoing approximately 10 collisions (p. 411, sect. 2.1, par. 2), which based on data in the *Douglas* patent (i.e., that the number of collisions is related to rod length multiplied by pressure, and a specific example wherein a chamber with 15 cm rods operated at a pressure of  $5 \times 10^{-3}$  torr results in an average of 15 collisions) suggests a rod length in the *Hanley*



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system of about 5 cm, which further suggests that the product of pressure and rod length would be about  $5 \times 10^{-2}$  torr-cm which is greater than or equal to  $2.25 \times 10^{-2}$  torr-cm.

Since this teaching is directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the *Hanley* reference as important in determining the patentability of the claims. As such, it is agreed that the *Hanley* reference raises a substantial new question of patentability with respect to at least claims 1-5, 9-18 and 22-30 of the *Douglas* patent.

#### Issue 2

The *Anderson* (Anderson II) reference is new prior art. *Anderson* teaches, among other things, a chamber (E) including a rod set (D) with length of 20 cm (see generally Fig. 1) operated at a pressure of  $10^{-2}$  Torr (p. 134, par. 1) for a product of pressure and rod length of  $20 \times 10^{-2}$  torr-cm which is greater than or equal to  $2.25 \times 10^{-2}$  torr-cm.

Since this teaching is directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the *Anderson* reference as important in determining the patentability of the claims. As such, it is agreed that the *Anderson* reference raises a substantial new question of patentability with respect to claims 1-5, 9-18 and 22-30 of the *Douglas* patent.

#### Issue 3

The *Boitnott* (Finnegan Paper) reference is old prior art first considered during the previous reexamination proceeding. During the first proceeding, the *Boitnott* reference was used as a secondary reference in a Non-Final Rejection (2/3/1998) for the teaching of an AC-only

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applied voltage of between 0 and 30 volts. In addition, it was noted by the Patent Owner in the original Request (page 19) that Finnigan "does not even disclose the length of the rods."

In the current request, the Third Party requester has submitted evidence (the Finnigan data sheet) suggesting the rod length of the Finnigan mass spectrometer was about 14 cm. This teaching tends to present the *Boitnott* in a new light not appreciated in previous proceedings.

The *Boitnott* reference further teaches, among other things, a pressure in quadrupole-2 of  $3 \times 10^{-3}$  torr (3 millitorr) (page 5, par 0 and Slide 7) which with a 14 cm rod set suggests a product of pressure and rod length of about 4.2 torr-cm which is greater than or equal to  $2.25 \times 10^{-2}$  torr-cm.

Since this teaching is directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the *Boitnott* reference as present in a new light as important in determining the patentability of the claims. As such, it is agreed that the *Boitnott* reference raises a substantial new question of patentability with respect to claims 1-2, 4-15 and 17-30 of the *Douglas* patent.

### **Conclusion**

### **Extensions of Time**

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

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#### **Waiver of Right to File Patent Owner Statement**

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R. 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

#### **Amendment in Reexamination Proceedings**

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR § 1.52(a) and (b), and must contain any fees required by 37 CFR § 1.20(c). See MPEP § 2250(IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

#### **Service of Papers**

After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550(f).

#### **Notification of Concurrent Proceedings**

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving

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Patent No. 5,640,497 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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All correspondence relating to this ex parte reexamination proceeding should be directed:


By Mail to: Mail Stop *Ex Parte* Reexam  
Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit


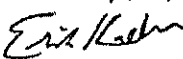
By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication should be directed to the Central  
Reexamination Unit at telephone number (571) 272-7705.

Signed:

  
Albert J. Gagliardi  
Examiner  
Art Unit 3992

Conferees:

FORM PTO-1449

Duplicate

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INFORMATION DISCLOSURE		ATTY. DOCKET NOS. 102993-100		REEXAM NO.: 90/008,608		
		IN RE PATENT OF: DOUGLAS ET, AL				
		PATENT NO.: 4,963,736		REEXAM GROUP ART UNIT: UNKNOWN		REEXAM CONF NO.: UNKNOWN
U.S. PATENT DOCUMENTS						
EXAMINER INITIALS	DOCUMENT NO.	ISSUE DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPR.
FOREIGN PATENT DOCUMENTS						
EXAMINER INITIALS	DOCUMENT NO.	ISSUE DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
OTHER DOCUMENTS (INCLUDING AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.)						
	Hanley, Luke and Anderson, Scott L, "Chemistry and Cooling of Transition Metal Cluster Ions," Chemical Physics Letters, Vol. 122, No. 4, pp. 410-414, 1985 ("Anderson I")					
	Anderson, Scott L. and Hanley, Luke, "Metal Cluster Ion Chemistry," SPIE Vol. 669 Laser Applications in Chemistry, pp. 133-136, 1986 ("Anderson II")					
	Boitnott, C.A., et al., "Optimization of Instrument Parameters for Collision Activated Decomposition (CAD) Experiments for a Triple State Quadrupole (TSQ <sup>TM</sup> ) GC/MS/MS/DS," Finnigan Topic 8160 ("Finnigan paper")					
	Johnston, Mark, "Energy Filtering in Triple Quadrupole MS/MS" 1984 (the "Finnigan application report")					
	"Triple Stage Quadrupole GC/MS/MS/DS System," 1981, describing the Finnigan TSQ mass spectrometer ("Finnigan data sheet")					
	Engineering Drawings of Collision Cell for Finnigan TSQ mass spectrometer ("Finnigan schematics")					
EXAMINER:				DATE CONSIDERED:		

\* EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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## FORM PTO-1449

95/008,608 9/25/2007

INFORMATION DISCLOSURE		ATTY. DOCKET NOS. 102993-100		REEXAM NO.: 90/008,608		
		IN RE PATENT OF: DOUGLAS ET, AL				
		PATENT NO.: 4,963,736	REEXAM GROUP ART UNIT: UNKNOWN		REEXAM CONF NO.: UNKNOWN	
U.S. PATENT DOCUMENTS						
EXAMINER INITIALS	DOCUMENT NO.	ISSUE DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPR.
FOREIGN PATENT DOCUMENTS						
EXAMINER INITIALS	DOCUMENT NO.	ISSUE DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES NO
OTHER DOCUMENTS (INCLUDING AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.)						
/AJG/	Hanley, Luke and Anderson, Scott L, "Chemistry and Cooling of Transition Metal Cluster Ions," Chemical Physics Letters, Vol. 122, No. 4, pp. 410-414, 1985 ("Anderson I")					
/AJG/	Anderson, Scott L. and Hanley, Luke, "Metal Cluster Ion Chemistry," SPIE Vol. 669 Laser Applications in Chemistry, pp. 133-136, 1986 ("Anderson II")					
/AJG/	Boltnott, C.A., et al., "Optimization of Instrument Parameters for Collision Activated Decomposition (CAD) Experiments for a Triple State Quadrupole (TSQ™) GC/MS/MS/DS," Finnigan Topic 8160 ("Finnigan paper")					
/AJG/	Johnston, Mark, "Energy Filtering in Triple Quadrupole MS/MS" 1984 (the "Finnigan application report")					
/AJG/	"Triple Stage Quadrupole GC/MS/MS/DS System," 1981, describing the Finnigan TSQ mass spectrometer ("Finnigan data sheet")					
/AJG/	Engineering Drawings of Collision Cell for Finnigan TSQ mass spectrometer ("Finnigan schematics")					
EXAMINER: /Albert Gagliardi/				DATE CONSIDERED 12/04/2007		

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<b>Notice of References Cited</b>	Application/Control No. 90/008,608	Applicant(s)/Patent Under Reexamination 4963736	
	Examiner Albert J. Gagliardi	Art Unit 3992	Page 1 of 1

## U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

## FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	EP 23826 A1	02-1981	European Patent	FRENCH et al.	
	O					
	P					
	Q					
	R					
	S					
	T					

## NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
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\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a) )  
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